

**Notice of Allowability**

Application No.

10/020,445

Examiner

Jegatheesan Seharaseyon

Applicant(s)

ASHKENAZI ET AL.

Art Unit

1647

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/20/2004.
2. ☒ The allowed claim(s) is/are 63, 68-70 and 74-77 are numbered 1-8.
3. ☒ The drawings filed on 24 October 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 9/20/2004
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

  
**JANET ANDRES**  
**PRIMARY EXAMINER**

Art Unit: 1647

### DETAILED ACTION

1. This Office Action is in response to amendments and remarks/arguments filed 9/20/2004. Claims 58-62, 66, 67 and 71-73 have been cancelled. Applicants have amended claims 63-65, 68-69 and 74. Claims 78-84 have added. Thus, claims 63-65, 68-70 and 74-84 are pending.
2. Applicants request to amend the list of inventors, under 37 C.F.R 1.48(b) is acknowledged and entered.
3. The Office acknowledges the change of the title.
4. The Office acknowledges PTO-1449 submitted on 9/20/2004, which has been considered
5. The Office also acknowledges the drawings submitted on 10/24/2001.

### EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Anna L. Barry on 1/27/05.

#### In the Claims

Please cancel claims 64, 65 and 78-84. Also please amend claim 76.

7 ~~78~~, (amended) An [A] isolated host cell comprising the vector of claim 74.

### REASONS FOR ALLOWANCE

7. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119. Applicants have argued that they are entitled to the benefit of the filing date of April 29, 1998 based on the disclosure that the claimed protein is a novel synaptogyrin protein which is a synaptic vesicle protein that is ubiquitously expressed in the nervous system in U. S. Provisional Application No. 60/083, 392 (see page 14). Although, the provisional application identified the instant invention to be a "novel synaptogyrin protein" based on homology, it did not disclose a patentable utility and is not enabling under 35 USC 112, as required under 119(e). Applicants have also argued that they are entitled to the benefit of the filing date of March 8, 1999 based on the disclosure amplification data in PCT/US99/05028 (see page 14). Although, the previous PCT application discloses the same polynucleotide and polypeptide sequences (SEQ ID NO: 161 and 162) as the instant specification, the disclosure do not impart utility to the claims and is not enabling for the instant invention under 35 USC 112, as required under 119(e). Therefore, the filing date of 24 October 2001 is considered as the priority date.

However, Applicants arguments are persuasive with respect to rejection under 35 U.S.C. 102 of claim 63, 68-70 and 74-77 as being anticipated by Kedra et al., Accession No. AJ002308, published 3/3/1998 because of *In re* Moore and *In re* Stempel. The declaration filed 9/20/2004 under 37 C.F.R. 131 by the instant inventor is able over come the art by showing that "as much of the claimed invention as is taught in

Art Unit: 1647

the reference has been reduced to practice by the Applicants prior to the date of the reference.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. Claims 63, 68-70 and 74-77 are numbered 1-8 and allowed.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jegatheesan Seharaseyon whose telephone number is 571-272-0892. The examiner can normally be reached on M-F: 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).